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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/761,401

Filing Date: January 22, 2004

Appellant(s): OLOFSSON, OLA

Thomas P. Pavelko
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 31, 2009 appealing from the Office action mailed October 15, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the Examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

NONE

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal, is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following U. S. Patents were relied upon by the Examiner

Moriau et al. (6,006,486)

Serino (6,357,197)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as noted in the Final Office Action (10/15/08). It is not clear what the "characteristic surface of a milled surface" and the "characteristic surface of a broached surface" are. Applicant is required to positively recite, and clearly defined the claimed invention. What is the characteristic? Examiner notes that characteristic as defined by Merriam Webster On-Line Diction is understood as, "a distinguishing trait, quality or property". With this understanding it is not clear what Applicant is claiming as the "characteristic". Appropriate correction is required to facilitate a clear understanding of the claimed invention and proper application of the prior art. Claim 32 as presently presented is not deemed allowable.

Claim Rejections - 35 USC § 102/Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 27-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Moriau et al. (6,006,486). Claims 24 and 27-31 are rejected as noted in the Final Office Action (10/15/08). Moriau discloses a floor comprising a first board comprising an edge, the edge comprising a tongue (9); a second board comprising an edge, the edge comprising a groove, the groove defined by an opening (81) in the edge and an inner most portion; the groove further comprising a depression (fig. 23) positioned in a portion distal the innermost portion wherein the first and second boards are joined by the tongue and grooves.

As to the recitation, “...the broached portion having angles sharper than possible by milling”, (clm. 28) this is treated as a product-by-process limitation, as, the claim positively defines either the tongue or groove to have both milled and broached portions and the tongue and groove to form a joint. Examiner notes that either the tongue or groove, having a broached portion having angles sharper than possible by milling, does not positively define an end resultant product, i.e. surface comprised of a plurality of boards having a joint connection between the boards that is patentably distinct from the prior art of record. Further examiner notes the process by which the end result product (surface comprised of plurality of boards having a joint connection between the boards) is made is not germane to the patentability of the end resultant product.

Regarding claims 24, 27-30 and 33, Examiner notes, “*wherein at least one of the tongue and groove comprise both a milled and a broached portion*”, “*the groove comprises both milled and broached portions*”, “*wherein the polymeric material is an extrudate before being milled*”, “*wherein at least one of the tongue and the groove is formed by broaching an impregnated milled portion*”, “*wherein at least one of the tongue and the groove comprising a burr-free broached portion*”, “*wherein at least one of the tongue and groove comprise a broached portion...not capable of being formed by milling*” and “*the surface created by a rotating milling tool...the surface of the grooves shows a smoother surface than that made by the rotating milling tool, the smoother surface formed by a broaching tool*” to be product-by-process limitations.

Accordingly, because Serino clearly discloses a (product) first and second boards having a tongue and groove joint, the process by which the tongue and groove of the boards is formed into a joint (i.e., milled, broached, sharp angles, burr-free & geometry not capable of being formed by milling) or extrusion before milling are not germane to the patentability of the claimed invention. Additionally, the claimed end resultant product (at least two boards having a tongue and groove joint/connection to create a surface) does not patentably distinguish over the prior art of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Additionally claims 24, 27-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (6,006,486). Claims 24 and 27-31 are rejected as noted in the Final Office Action (10/15/08). As noted above, the claims are deemed product-by-process

claims, therefore, the process (broaching, milling) by which the end resultant product of a floor is created is not germane to the patentability of the product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is *based on the product itself*; therefore the floor. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23, 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (6,006,486) in view of Serino et al. (6,357,197) as noted in the Final Office Action (10/15/088). With regard to claims 21 and 23, Moriau does not disclose the tongue and groove comprise a milled polymeric material, the polymeric. Serino discloses the tongue and groove both to comprise a polymeric material. Examiner notes the adhesive (19) between the tongue and groove to be a polymeric material because it consists of a thermoplastic. Applicant's disclosure states an admitted prior art that, thermoplastic is a type of polymeric material. Accordingly because Serino discloses board (17) to be comprised of a thermoplastic material and

use of an adhesive that is also a thermoplastic material, Serino anticipates a tongue and groove comprised of polymeric material.

With regard to claim 22, Serino discloses the tongue (16) to be glued (18) to the groove/ board (13). Accordingly it would have been obvious to the skilled artisan to construct Moriau such that the tongue is glued to the groove for efficiently securing the tongue and groove joint as taught by Serino.

With regard to claim 23, Serino discloses a polymeric material (col. 3, lines 35-50); Examiner notes a thermoplastic polymer to be a polymer material.

With regard to claims 25 and 34, Moriau and Serino disclose wherein at least one of the first board and the second board comprises a core, the core being formed from wood medium density or high density fiber board (Moriau col. 3, lines 14-17, 35-37).

(10) Response to Argument

Appellant's remarks are not deemed persuasive. Initially, Appellant argues that the 35 U.S.C. 112 rejection of claim 32 is not only clear but well known to those having ordinary skill in the art (Appeal Brief, Pg. 5). Appellant further references the specification and Declaration of Fredrik Schlyter that the claimed invention as recited in claim 32 is clear and therefore not indefinite. This argument is not deemed persuasive, because, Appellant is utilizing structure, processing and tools not positively recited within the claimed invention to provide clear understanding of the claim language. As noted in the final rejection the recitations, "characteristic surface of a milled surface" and the "characteristic surface of a broached surface" render the claim indefinite. Examiner further noted that the "characteristic" is not clear and has not been positively recited. In response, Appellant argues that the "characteristic surface of a

milled surface as defined by the specification and Declaration "requires the rotation of the cutting tool, rotating at a high speed with respect to the work...milling involves a rotating tool operating at a high speed and when used to form the Joint Edges of the panels of the instant claim 32, would have poor tolerance because of the vibration and flexing inherent in such milling operation. Appellant further argues that the "characteristic surface of a broached surface" as defined by the specification and Declaration is "similar to planeing in which each tooth of the broaching removes a small amount of material in progressive heights because each of the teeth are arranged to cut progressively deeper into the material. Examiner takes the position that Appellant is arguing criticality of the characteristics of both a milled surface and a broached surface that have not been positively recited in the claimed invention, therefore to merely recite, "characteristic surface of a milled surface" and the "characteristic surface of a broached surface" is not clear and the rejection stands.

In response, to Appellant's remarks regarding the prior art rejections, Appellant argues that neither the prior art, Moriau et al. (6,006,486) nor Serino (6,357,197) serve to anticipate nor render obvious the claimed invention. Appellant argues, that the prior art, Moriau fails to teach "the broached portion having angles sharper than possible by milling". Appellant further argues that Examiner's position that claim (28) and the recitation, "the broached portion having angles sharper than possible by milling" as a product-by-process limitation(s) is incorrect and erroneous because the limitation is structural. Appellant further states, that the "supposed product-by-process limitation, the limitation in question is structural, not process, i.e., "having *an angle* not possible by milling" (emphasis added, Appeal Brief, Pg. 8) and further states, the angles now required within the grooved portions of the panels are impossible to form solely by rotating tools

of which milling is exemplary". In response to this, Examiner notes that any surface has an angle, i.e., even a straight surface is an angle of 180°, therefore the presence of an angle is structural, however the recitation, "not possible by milling" is process and/or method and clearly defines the process by which the angle can or can not be constructed. Accordingly the limitation is correctly deemed a product-by-process limitation. Appellant states, the prior art, "*Moriau only teaches milling, never mentions broaching* and thus cannot possibly act to anticipated the claimed subject matter...Thus the Examiner's position that the recitation of structure having an angle not possible by milling is not really a structure at all but rather a process limitation is clearly erroneous" (Appeal Brief Pgs. 8-9). As noted above the presence of an angle is structural however the process by which the angle is formed renders the limitation a product-by-process limitation and because the end result as defined by the claim(s) is a floor and not an angle the process by which the end resultant floor is constructed is not germane to the patentability of the claimed invention/floor. Furthermore, milling is defined as the operation of cutting, shaping, finishing or working product or workpiece; forming a product from a workpiece, which product may include protuberances intended to interfit with pockets in a cooperating member; cut by a rotating cutter that forms a shaped surface on the workpiece; or cut by a cutter that reciprocates and forms a shaped surface on the workpiece. Broaching is defined as toothed tools, including which may include reciprocation and/or rotary action used to finish surfaces of a workpiece/product. Because both milling and broaching tools are designed to remove material/shape and finish a workpiece broaching is deemed a derivative of milling. Further, neither the milling nor the broaching tool nor any structure related thereto have been positively recited in either the claimed invention nor defined in the disclosure; such are only

disclosed as process/method steps. Accordingly to merely state, "not possible by milling" does not impart structure nor define rotary or any other form of broach. Also, Moriau (figs. 1-11, 22-25) clearly discloses the use of at least two milling cycles or passes and thus two milling cutters of differing sizes. Moriau teaches an initial first rough cut and then the use of differing cutters to "finish" or *broach* the complicated (i.e., the angle; Moriau Figures 5, 6, 22-25) forms of the tongue and groove joints formed.

Examiner notes Appellant is not claiming the end resultant angle or the structure of the angle, but instead the process by which the angle is formed, as the angle relates to either the tongue (protruding surface) or the groove (recessed area) therefore a product-by-process claim limitation. Furthermore, as noted above, the scope of the claim(s) is drawn to a floor (as evidenced by the claim preamble) where the floor is comprised of a first board/panel having a tongue and second board/panel having a groove, wherein the tongue is inserted into the groove; therefore the end result of the claimed invention is a floor made of two boards/panels that are secured together by a tongue of one board/panel inserted into the groove of the second board/panel. Thus the structure of either the tongue or the groove is not an end result but instead an intermediary structural process by which the tongue and or groove joint is formed so as to created the finished end resultant floor. Accordingly, Examiner's position that the claimed invention is a product-by-process claim is proper and therefore stands.

In response to Appellant's arguments that the prior art, Moriau fails to anticipate or render obvious the invention, because, Moriau, "only teaches milling, never mentions broaching" this argument is not deemed persuasive, because as noted above, the claim is a product process claim drawn to an end resultant floor comprised of two boards/panels each having an edge; one

board/panel a tongue edge the other board/panel a grooved edge, wherein the boards/panels are secured together via the tongue and groove connection/edges. The recitation to how either the tongue or groove edges of the boards/panels are constructed is a process step not given patentable weight in a product claim. Further the process by which a product is constructed absence any patentably distinguishing structure of the final product/end result is not germane to the end resultant product of the claimed invention. Because the end result is a finished floor constructed of the secured boards/panels, the process by which intermediary structure of the end result is formed as noted above is not germane to the patentability of the end result floor. Therefore, the rejections noted both above and in the Final Rejection are deemed proper and therefore stand.

In response to Appellant's arguments that the limitations "tongue and groove comprise both a milled and a broached portion...at least one of the tongue and groove is formed by broaching an impregnated milled portion...not only is clearly erroneous wherein the recitations are clearly structural, for example...tongue and groove comprising a burr-free broached portion...not having anything to do with product-by-process" is not deemed persuasive. As noted above, the claims are deemed product-by-process limitations because the structure is defined by how it is made, i.e. processed therefore product-by-process claims.

Finally, Appellant argues that the secondary teaches of Serino also fail to teach or disclose broaching. This however is not deemed persuasive, because as noted above, the claims are deemed product-by-process claims and the process by which the tongue and or groove of the boards/panels is formed is not germane to the end resultant product of a floor. Regarding Appellant's arguments that Appellant is not claiming a floor formed by milling...or broaching

but rather specific parts of the structure of the individual panels...to exhibit tongue and groove portions which exhibit surfaces not found in the prior art, this is not deemed persuasive, because the preamble of the claims clearly states, "a floor...", therefore the scope of the invention is drawn to a floor. The specifics of the process of forming the individual parts (i.e., broaching, milling, use of rotary tools) of the floor are not germane to the floor and do not patentably define the claimed invention floor over that of the prior art floor tongue and groove jointed panels.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

\Shelley Self\ Primary Examiner, AU 3725

September 29, 2009

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Enclosure: IDS filed 1/15/09